

## **REMARKS:**

The present amendment is in response to the Office Action received on Sep. 29, 2004, in which Claims 1-6, 11-17 and 24-28 were rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the reference cited therein. The following remarks are believed to be fully responsive to the Office Action and render all claims at issue patentably distinguishable over the cited references.

Reconsideration and withdrawal of the rejections set forth in the Office Action dated Sep. 29, 2004 are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 103**

Rejection of Claims 1-6 and 11-17 under 35 U.S.C. 103(a) as being unpatentable over Herzog (US Patent, No. 6,353,737) and in view of Verstijnen (US Patent, No. 5,733,147) and Japanese document 63,168,755

Claims 1-6 and 11-17 are withdrawn, and the patentability of added Claims 33-50 is discussed with cited prior arts.

According to Claim 33, a system for SIM card backup is provided. Herzog disclosed the SIM card connection, the processor, memory, the power supply and the input means, but failed to disclose the backup mechanism of data in SIM card. In accordance with the specification of the present application, one of the main purposes of the present invention is the backup of data in SIM cards. Therefore, the data security of SIM cards is the most significant feature of the present invention, and results of the claimed system certainly can not be expected by Herzog.

However, the Examiner believed that the disclosure of Herzog combined with Verstijnen and the Japanese document may make the present application obvious to one having ordinary skill in the art. According to the Japanese document, a backup system for IC card is disclosed. The Japanese document failed to disclose any input means for controlling the backup operation and any displayer for showing the data in the IC card or the memory. It should be noted that the backup mechanism, namely the manipulation of backup operation,

including the input means for inputting instructions and the processor for controlling the backup process in Claim 33, is crucial in the present invention, yet all of the three citations fails to disclose such critical characteristics of the present invention. Pursuant to *Papesch*, "the presence of a property not possessed by the prior art is evidence of nonobviousness,"<sup>1</sup> the combination of the Japanese document, Verstijnen and Herzog can not render the present invention obvious or unpatentable.

Since Claims 34-38 depend on Claims 33, all of them should be patentable under the patentability of Claim 33.

Claims 39 and 46 respectively disclose a communication device and a PDA, and both apparatuses are provided with the SIM card backup mechanism. Again, the combination of the Japanese document, Verstijnen and Herzog fails to teach the backup mechanism of the present invention, and therefore can not render the present invention obvious or unpatentable.

In addition, the communication device of Claim 39 integrates the phone (including cellular phone and telephone) and the SIM card backup system. According to Herzog, the device therein merely uses the SIM card for identification, which is the basic function of SIM, and the input means is merely used for dialing someone else. Referring to the Japanese document, the IC card backup system only transferring the data between the IC card and the memory. There is no mention about the identification or communication functions. Hence, the Japanese document, Verstijnen and Herzog fail to teach not only the backup mechanism but also the integration of communication, identification and SIM card backup system. The noteworthy results of the present invention are unexpected for the cited prior arts. Since absence of property which a claimed invention would have been expected to possess based on the teachings of the prior art is evidence of unobviousness<sup>2</sup>, the Claims 39 and 46 are surely unobvious in view of the three citations.

Besides, throughout the disclosure of the three citations, there is no attempt to combine the communication device with the SIM card backup system. Therefore, the communication device with SIM card backup mechanism is naturally unobvious over the three citations.

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<sup>1</sup> *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)

<sup>2</sup> *Ex parte Mead Johnson & Co.* 227 USPQ 78 (Bd. Pat. App. & Inter. 1985)

Since Claims 40-45 and 47-50 respectively depend on Claims 39 and 46, all of them should be patentable under the patentability of Claims 39 and 46.

In conclusion, Claims 33-50 should be unobvious since their results are unexpected to the three citations and the combination thereof.

Rejection of Claims 24-28 under 35 U.S.C. 103(a) as being unpatentable over Herzog in view of Verstijnen, Japanese document 63,168,755 and Erola (US Patent, No. 6,353,737)

Claims 1-6 and 11-17 are withdrawn, and the patentability of added Claims 33-50 is discussed with cited prior arts.

Erola disclosed the usage of SIM card in a PDA. The SIM card used in the PDA of Erola is merely applied for identification, which is the basic function of SIM. With the same reason described above, Erola combined with other three citations still fails to teach the main characteristics of the present invention, and therefore the present invention is unobvious and patentable over the four citations of prior art.

It should be noted that the Examiner cited four citations from diverse technical fields, but the properties which the claimed invention would have been expected to possess are still absent based on the teachings of the prior arts. Accordingly, the present invention is certainly unobvious and patentable because of the failure of others, which is one of the secondary considerations as the matter of unobviousness. Besides, throughout the disclosure of the four citations, there is no attempt to combine the PDA with the SIM card backup system. Therefore, the PDA with SIM card backup mechanism is naturally unobvious over the four citations.

Since Claims 47-50 respectively depend on Claim 46, all of them should be patentable under the patentability of Claim 46.

In conclusion, Claims 46-50 should be unobvious since their results are unexpected to the three citations and the combination thereof.

Applicant believes that the response traverses the rejection under 103. Reconsideration and withdrawal of these rejections under 103 set forth in the Office Action are respectfully requested.

## **II. Conclusion**

In view of the foregoing, Claims 33-50 pending in the application comply with the requirements of patentability define over the applied art. A Notice of Allowance is, therefore, respectfully requested.